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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,191	03/29/2001	Martin A. Kenner	56095US002	4517

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EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/821,191

Applicant(s)
Kenner et al.

Examiner
John Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 29, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152) _____
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 6) ☐ Other: _____

[Handwritten signature]
9-4-2003

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful
process, machine, manufacture, or composition of matter or
any new and useful improvement thereof, may obtain a
patent therefore, subject to the conditions and requirements
of this title.

2 Claims 1-9, 11-19 & 21-24 are rejected under 35 U.S.C. 101, because the claims are directed to non-statutory subject matter.

As per independent claim 1, as drafted the claim is not limited by language to a useful, concrete and tangible application within the technological arts. Claim 1 suffers from undue-breadth.

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It is well settled in the law that “Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which applicants regard as their invention. . . . a rejection under 35 U.S.C. 112, second paragraph would be appropriate. . . . If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate.” (See MPEP 2173.04 Breadth Is Not Indefiniteness (August 2001) p. 2100-195).

Furthermore, it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05(q)).

Also, it is well settled in the law that “A process that merely manipulates an abstract idea . . . is nonstatutory despite the fact that it might inherently have some usefulness. See *Alappat*, 33, F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). In this case, claim 1 is drafted so broadly that it is merely a method of (1) “posting a note at a content provider. . . .” as drafted, there is no exclusion of a claim of a person physically passing a post-it note along to another

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person who provides some kind of content; i.e., nothing in the claim suggests that any application of technology is required in “posting a note at a content provider. . . .”

Claims 2 -9, 11-19 & 21-24-21 are rejected for substantially the same reason as claim 1, because said claims depend from claim 1 and/or subsequent base claims which depend from claim 1.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morton 6,327,572; class 705/10 (12/04/2001) [US f/d: 12/06/1999] (herein referred to as “Morton”).

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As per claim 1, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows: “A method comprising: posting a note at a content provider, wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity.”

Morton lacks an explicit recitation of “wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity. . . .” It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) would have been selected in accordance with “wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity. . . .” because, such selection would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

As per claims 2-28, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 1 and

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subsequent base claims depending from claim 1.

Morton lacks explicit recitation of the elements and limitations of claims 2-28, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-28 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-28, because such inclusion would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

Independent claim 29 is rejected for the same reasons as independent claim 1.

As per claims 30-40, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 29 and subsequent base claims depending from claim 29.

Morton lacks explicit recitation of the elements and limitations of claims 30-40, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 30-40 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 30-40, because such

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inclusion would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

Independent claim 41 is rejected for substantially the same reasons as independent claim 1.

As per claims 42-68, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 41 and subsequent base claims depending from claim 41.

Morton lacks explicit recitation of the elements and limitations of claims 42-68, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 42-68 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 42-68, because such inclusion would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

CONCLUSION

4. Any response to this action should be mailed to:

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Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

Patent Examiner

September 4, 2003